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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,604	06/15/2000	HIROKAZU TANAKA	1217-001125	9815

7590 04/19/2002

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EXAMINER

AHMED, SHEEBA

ART UNIT

PAPER NUMBER

1773

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DATE MAILED: 04/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/581,604

Applicant(s)
Tanaka et al.

Examiner
First Last

Art Unit
1234



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 19, 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

1. Amendments to the Specification have been entered in the above-identified application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

2. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kayanoki (US 5,963,373).

The above rejection is maintained for the reasons of record as set forth in Paragraph No. 1 of the Office Action mailed on September 25, 2001 (Paper No. 4).

Response to Arguments

3. Applicant's arguments filed on December 19, 2001 have been fully considered but they are not persuasive. Applicants traverse the above rejection and assert that the claimed weight ratio of the iron oxide to the titanium oxide (i.e., 0.0005 to less than 0.005) in the composite particles of the hard coat composition leads to unexpected results, i.e., the resulting hard coat film is free from photochromism and a yellow tint and has weather resistance. To support such an assertion, the Applicants point the Examiner to Example 1 (wherein the weight ratio of the iron oxide to the titanium oxide is 0.002) and Comparative Example 1 (wherein the weight ratio of

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the iron oxide to the titanium oxide is 0.02) of the instant application which shows that the hard coat film of example 1 is free from photochromism and has excellent weather resistance.

However, the Examiner takes the position that such a showing is not commensurate with the scope of the claimed weight ratio of the iron oxide to the titanium oxide (i.e., 0.0005 to less than 0.005) in the composite particles of the hard coat composition. The results set forth in Example 1 and Comparative Example 1 compare a weight ratio of 0.002 to 0.02 and indicate that the hard coat film of Example 1 is free from photochromism and has excellent weather resistance whereas the hard coat of Comparative Example 1 does not. The range of data exemplified in the showing is not commensurate with the entire range claimed. Specifically, there are no data points towards the lower weight ratio of 0.0005.

Applicants further argue that the composite of Terasse is a mixture of metal oxide particulates and silica agglomerates and not the composite oxide of the present invention and that Terasse contains no teaching concerning the claimed range of weight ratio of the iron oxide to titanium oxide. First, the Examiner would like to point out that Terasse is simply used as evidence to show that it is known that the weight ratio of various metal oxides and silica can be varied to obtain varying properties. For example, UV shielding function can be imparted to a composite material by varying the amount of titanium oxide, zinc oxide and iron oxide. Second, Terasse does pertain to the composite oxide of the present invention since a composite is simply defined as "a solid material having two or more substances having different physical characteristics and in

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which each substance retains its identity while contributing desirable properties to the whole”.

Hence, the above rejection is maintained for the reasons of record.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Sheeba Ahmed whose telephone number is (703) 305-0594. The Examiner can normally be reached on Monday-Friday from 8am to 5pm.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Paul Thibodeau, can be reached at (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5436.

SA
Sheeba Ahmed
April 14, 2002


Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700